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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,235

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Ryoji Watanabe

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10/03/2006

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EXAMINER

PAHNG, JASON Y

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,235

Applicant(s)

WATANABE ET AL.

Examiner

Jason Y. Pahng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11,13,14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11,13,14 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Examiner's Interview dated June 26, 2006, the Final Rejection dated July 20, 2006 has been withdrawn. However, a new Final Rejection is provided herein.

Claim Objections

With regard to claim 4, the phrase, "applies destroys" (line 2), is grammatically incorrect.

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-9, 11, 13, 14, and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, lines 7 and 8, the paper including an electronic data storage device is incorrect because the electronic data storage device (420) is attached to the paper (40) according to the specification.

With regard to claim 1, line 13, the electronic data storage device of entered paper is incorrect because the electronic data storage device (420) is attached to the paper (40) according to the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, as well as can be understood, 2, 5, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Bennett et al. (US 6,758,392) and Colgate, Jr. (US 4,547,002).

With regard to claims 1, 2, and 5, Chang discloses substantially all of the claimed structure including:

1. a transport path (12)
1. a destroy process unit (1) that destroys data stored in an electronic data storage device of an image display member or a credit card;
2. a shredding process unit (20, 30) that shreds the image display member or a credit card; and
3. a sensing unit (14).

Chang discloses a sensing unit (14) to detect an image display unit, but does not disclose detecting an electronic data storage device or a control unit. In a closely

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related art, disclose detecting an electronic data storage device. In a closely related art, Bennett discloses a credit card destroy process unit with a sensor and controller capable of detecting an electronic data storage device in order to control the destruction (column 1, lines 28-39 and 62-66). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang with a sensor and controller capable of detecting an electronic data storage device in order to control the destruction, as taught by Bennett. Although Chang does not explicitly disclose a display member comprising paper, Colgate is referenced to show that credit card may be made of either plastic or paper.

With regard to claim 6, Chang discloses an insertion port (12) wherein the destroy process unit (1 and including 15) is disposed closer to the insertion port (12) than the shredding process unit (20, 30).

With regard to claim 11, Chang discloses a sensor (13) which senses the presence of an image display member in order to control at least the shredding process.

Claims 4, 7-9, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 6,676,050) in view of Bennett et al. (US 6,758,392) and Colgate, Jr. (US 4,547,002) as applied above, further in view of Abramson (US 4,931,770) and Matsumoto et al. (US 4,879,724). Claim 4 calls for at least one of electric or magnetic application, and claim 9 calls for electromagnetic wave to overwrite another data to destroy data. In a closely related art, Matsumoto discloses a rewritable optical disk memory system (column 1, lines 21-23) and therefore inherently discloses overwriting another data to in order to destroy data. In another closely related art, Abramson

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teaches that using abrasive, cutting, chemical, magnetic, or other suitable component adapted to destroy information on a disc is well known in the art (column 2, lines 30-32). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang (as modified) with a rewritable optical disk memory system in order to destroy data in a disc, as such is well known in the art and taught by Matsumoto and Abramson.

With regard to claims 7 and 18, the modified device of Chang is capable of shredding or applying electric field. Whether the image display unit is shredded first and electric field is applied later or electric field is applied first and shredded later is not relevant. How an apparatus is used is considered in a process claim and is not germane to the patentability of an apparatus claim.

Claim 8 does not add any further limitation to claim 4. The use of electric field claimed in claim 4 would inherently include application of voltage.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 6,676,050) in view of Bennett et al. (US 6,758,392) and Colgate, Jr. (US 4,547,002) as applied above, further in view of Bley (US 6,038,012). Claims 13 and 14 call for the electronic data storage device to comprise an IC chip. In a closely related art pertinent to the problem, Bley discloses an electronic data storage device comprising an IC chip (column 1, lines 56-58) in order to make a card to be a smart card. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Chang (as modified) with an electronic data storage

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device comprising an IC chip in order to make his card to be a smart card, as taught by Bley.

Allowable Subject Matter

Claims 16 and 17 are allowed.

Response to Arguments

Applicant's arguments filed July 10, 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues against the Chang reference alone in page 6. However, none of the claims are rejected by Chang alone. For example, claim 1 is rejected in view of Chang, Bennett, and Colgate as set forth above.

Applicant does not present additional new arguments.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Y. Pahng whose telephone number is 571 272 4522. The examiner can normally be reached on 9:00 AM - 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571 272 4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JYP



Lowell M. Smith
Primary Examiner